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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,380	12/28/2000	Denny Ho	101229-00000	5574

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,380

Applicant(s)

HO, DENNY

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzillo, Jr. et al. (US 20020032602A1) in view of Scroggie et al. (US005970469A).
3. Lanzillo, Jr. et al. teaches (independent claims 1, 9-14 and 17-20) a system, server, apparatus, method and record medium for controlling sales promotions using direct mail based on an Internet technology, the method comprising: determining whether or not issued direct mail was opened (browsed) through a direct mail open acknowledge request option, and automatically storing this event in database records to permit the identification of active users and a record of ad penetration (para. [0021]), which reads on automatically controlling sales promotion activities for commodities advertised in the direct mail based on the determined result. Lanzillo, Jr. et al. also teaches an assignment state of a benefit (a *coupon in the message*, para. [0020]) and a transaction history of commodities on an online shopping system (para. [0023], where *camping* is an example commodity).
4. Lanzillo, Jr. et al. does not teach obtaining a customer number, a commodity code and a transaction date from a POS register terminal device. Scroggie et al. teaches obtaining a customer number, a commodity code and an expiration date from a POS register terminal device (col. 9 line 67 to col. 10 line 4). Because Scroggie et al. teaches that this enables a more focused promotion (*incentive*, col. 4 lines 33-35), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Scroggie et al. to those of Lanzillo, Jr. et al.
5. Neither reference teaches obtaining a transaction date from a POS register terminal device. Because it is necessary to compare with the expiration date, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of

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Scroggie et al. and Lanzillo, Jr. et al. that a transaction date be determined from a POS register terminal device.

6. Scroggie et al. also teaches matching and verifying customer, promotion and purchased commodity a POS register terminal device (col. 11 lines 57-63), which reads on referencing bargain (*incentive*) information stored in a transaction information managing unit (*storage device 306*); setting the sales price to the regular price if either the commodity is not confirmed to be the promotion commodity, or if the customer is not confirmed to be the direct mail (*E-mail*, col. 12 lines 53-56) recipient; and setting the sales price to the promotion price if all criteria are met.
7. Neither reference teaches determining at the POS whether or not the customer is a direct mail browser, and offering different promotion prices for browsers versus non-browsers. Because it is convenient to perform all the verifications at the same time, and because the merchant would want to promote the opening (browsing) of the direct mail/email messages, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Scroggie et al. and Lanzillo, Jr. et al. that it be determined at the POS whether or not the customer is a direct mail browser, and that different promotion prices be offered for browsers versus non-browsers.
8. Lanzillo, Jr. et al. also teaches at the citations given above claims 4, 5 and 15. Lanzillo, Jr. et al. also teaches claim 6 (para. [0041] and [0008]).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
12. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
14. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
15. Applicant may have after final arguments considered and amendments entered by filing an RCE.
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last

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Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

4 December 2005